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HAROLD B. WILLEY, Cl

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. 580

WARNER BROS. PICTURES, INC. and ALFRED A. KNOPF, INC.,
Petitioners,

v.

COLUMBIA BROADCASTING SYSTEM, INC., WILLIAM SPIER, THE WILDROOT COMPANY, INC., REGIS RADIO CORPORATION, WILLIAM ROBERT TALLMAN, GILES B. DOUD, JOE EISINGER, BATTEN, BARTON, DURSTINE & OSBORN, INC., and DASHIELL HAMMETT,

Respondents.

REPLY OF PETITIONERS TO ANSWERS OF RESPONDENTS

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The two briefs filed in opposition to the petition demonstrate, we submit, that the issues in this case should be decided by this Court.

1. In neither brief is it disputed that Sam Spade and the other characters of "The Maltese Falcon" are original, well-developed and distinctive. They are characters of the kind which Chief Judge Learned Hand indicated would be, and Circuit Judge Augustus Hand held to be,

protected by the Copyright Act. *Nichols* v. *Universal*, 45 F. 2d 119, 121 (CCA 2, 1930); *Detective Comics* v. *Bruns*, 111 F. 2d 432 (CCA 2, 1940).

2. The brief of Respondents C.B.S. *et al.*, in outright defense of the Court below, sets up as its Point II—**"The character rights are not within the protection of the Copyright Statute"** (C.B.S., p. 8). The comments of Chief Judge L. Hand in the *Nichols* case are passed off as "speculative reflections". The other four character cases cited in the petition (pp. 11-12) are passed off as involving "pictures or cartoons * * * as well as textual matter and literary expressions accompanying the pictures and cartoons" (C.B.S., p. 12). This ignores the fact that the opinion in the *Detective Comics* case applied the same test to the copyrightability of cartoon characters as the *Nichols* case applied to the copyrightability of literary characters.

Circuit Judge A. Hand by his citation of the *Nichols* case in the *Detective Comics* case shows that in his view there is no difference in this regard between a cartoon character and a literary character.[1]

Respondent Hammett, apparently recognizing that there is no distinction between literary and cartoon characters in this regard, is more cautious in his defense of the Court's holding that characters are not protected by copyright. His brief states, p. 7, that the courts "conceive the copyright question as one limited to *textual appropriation*, i.e., whether the expression of pictorial or literary details, including specific incidents or exploits, has been copied". (Emphasis supplied.)

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[1] Incidentally the character protected in the *Detective Comics* case was actually in part cartoon and in part literary. The character "Superman" was delineated by "pictorial representations and verbal descriptions" (*Detective Comics, supra* at 433; petition, p. 11).

When a character in a copyrighted work is original, well-developed, and distinctive, the character is a part of the copyrighted work and has the protection of the copyright. When the *identical character* with the *same characteristics* is *copied* in another work, the subsequent work infringes the copyright. The characters used in the radio series in the present case were the *identical characters,* with the *same characteristics* as those contained in the novel, and they were *copied* from the novel (R. 137-138, 324-325), and the Court so found (R. 90).[2] Therefore it is no answer for Respondent Hammett to say that there was no "textual copying". Furthermore, the law of copyright has long since outgrown such rigid formalized thinking. See petition, p. 12, footnote (6).

3. Respondents' briefs, their Questions Presented and the opinions of the District Court and the Court of Appeals all indicate that their theory of the present case is based on a fundamental, erroneous *assumption:* that there are such things as "character rights" in published works which are not included in the copyright but which exist in the law separately and apart from the Copyright Act; that when a copyright is assigned, these "character rights" are not conveyed because they are not included in the copyright; and that consequently when Warner was granted exclusive dramatic rights (except spoken stage rights) in the novel under copyright, it did not acquire such rights with respect to the characters because "character rights" were not specifically granted. Neither Respondents nor the courts below have cited a single authority to support this emasculation of the Copyright Act.

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[2]Respondent Hammett is inaccurate when he states in his brief, p. 4, "This [radio] series merely used the characters by name".

4. Both Respondents offer the thesis that the author's protection against piracy of his characters lies in the law of unfair competition.

The C.B.S. brief, p. 10, says:

> "Character rights are analogous to trademark rights, and the author may prevent their use by means of unfair competition remedy in the same manner as the use of titles."

The Hammett brief, p. 8, says:

> "The right to the use of the *publicized named* characters created by an author and *identified with him* is protected, unless abandoned, under the common law doctrine of unfair competition and vests in the author and his assigns. See *Fisher* v. *Star Co., supra* (pp. 431-433)." (Emphasis supplied.)

Thus, both briefs claim that the author's right to protection depends upon the establishment in the public mind of a secondary meaning by both publication and publicity (Hammett, p. 8; C.B.S., p. 11).

We submit that Respondents' thesis would work great hardship upon authors whose characters are pirated. They would be deprived of the effective remedies under the Copyright Act in the federal courts. Furthermore, although there has been copying, they would still have to meet, often in the state courts under conflicting state laws, all of the difficult and sometimes vague requirements upon which the remedy of unfair competition is grounded.

Under Respondents' thesis, although "Scarlett O'Hara", and perhaps "Rhett Butler", might be protected, other less publicized, yet flawlessly delineated, characters from "Gone With The Wind" (as well as other works), could be freely appropriated. Moreover, if the

character were taken but with a new name substituted for the original name there would be no protection at all under Respondents' thesis.

Both briefs also ignore the hardship which would be imposed upon the public if copyright protection for original literary characters were abolished and the protection of such characters were limited to the law of unfair competition. According to Respondents, such remedy obtains after publication, even if the work is in the public domain. In support of this proposition they cite *Fisher* v. *Star Co.*, 231 N. Y. 414, 132 N. E. 133 (1921) cert. den. 257 U. S. 654 (Hammett, p. 8; C.B.S., pp. 9, 13). This would mean that after the expiration of the copyright in "The Maltese Falcon," if the public still remembers Sam Spade, Hammett and his heirs could enjoin the use of Spade by others. See petition, p. 10. The effect would be to create a species of perpetual copyright in published works. This result would be contrary to the Copyright Act and the Constitutional provision for protection "for limited times" (Art. 1, §8).

Petitioners have shown that characters in a published work are not protected by unfair competition unless they are also protected by copyright. The cases cited in the petition, p. 10, in support of this rule are ignored by Respondents, except that Respondent Hammett attempts (Hammett, p. 9) to distinguish *Atlas Mfg. Co.* v. *Street & Smith*, 204 Fed. 398 (CCA 8, 1913), cert. den. 231 U. S. 755, while overlooking the primary ground of the Court's decision:

> "Literary property in a book cannot be protected by trade-mark, nor otherwise than by copyright" (204 Fed. 402).

The only case relied upon by Respondents for their thesis to the contrary is *Fisher* v. *Star*. But in that case

the New York state court treated the characters Mutt and Jeff as being under copyright (231 N. Y. at 432-433) and for that reason protected them under principles of unfair competition. This is made additionally clear by the earlier Mutt and Jeff case, *Hill* v. *Whalen & Martell*, 220 Fed. 359 (S.D.N.Y., 1914), where an injunction was issued under the Copyright Act enjoining the piracy of these characters.

5. There is a final point on which Respondents differ. C.B.S. recognizes that the Court below *held* that (in C.B.S.'s words) "the copyright alone does not protect character rights." C.B.S., p. 5. Hammmett contends that this part of the Court's opinion is *obiter*. Hammett, p. 6. We submit that C.B.S. is right on this point. See petition, pp. 7, 8.

Respectfully submitted,

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